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**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q55595

Kenichi MIYAZAKI

Appln. No.: 09/386,000

Group Art Unit: 3651

Confirmation No.: 9906

Examiner: Patrick H. MACKEY

Filed: August 30, 1999

For: LARGE PRINTER

**SUBMISSION OF PETITION UNDER 37 C.F.R. § 1.182 AND/OR § 1.183 AND THE  
REQUIRED FEE**

**MAIL STOP PETITION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant hereby submits a petition under 37 C.F.R. § 1.182 and/or § 1.183 for the entry of a Reply Brief along with a check for the required fee under 37 C.F.R. § 1.17(h) of \$130.00.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this transmittal letter is attached.

Respectfully submitted,

SUGHRUE MION, PLLC  
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Grant/K. Rowan  
Registration No. 41,278

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: August 14, 2006

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**PETITION UNDER 37 C.F.R. § 1.182 AND/OR § 1.183**

**FOR ENTRY OF REPLY BRIEF**

**MAIL STOP PETITION**

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P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In the Supplemental Examiner's Answer dated June 13, 2006, the Examiner indicates that he is not considering the Reply Brief filed October 11, 2005, because it relies on the User Manual for the OCE 9400 device, which Applicant enclosed with the Reply Brief. Applicant respectfully requests that the Examiner enter and consider the Reply Brief.

An explanation of the background facts and the reasons for entering and considering the Reply Brief are provided below.

**I. Background Facts**

In the non-final Office Action dated July 30, 2004, the Examiner rejected various claims under 35 U.S.C. § 102(b) as being "clearly anticipated" by the "OCE 9400 device." (Page 3 of July 30, 2004, Office Action). Since the Examiner maintained that the claims were "clearly anticipated," the Examiner did not provide any rationale as to how the claims read on the device.

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FOR ENTRY OF REPLY BRIEF

However, based on the PTO-948 Form attached to the Office Action, the Examiner apparently relied on the Digital ES printout (Attachment A) and the Microstation Magazine (MSM Online) printout (Attachment B). Nonetheless, the disclosure of these printouts is so vague that Applicant could not reasonably determine how the Examiner is attempting to read the claims on the OCE 9400 device.

Accordingly, Applicant filed an Amendment on November 1, 2004, and clearly sought the Examiner's elaboration on the basis for the rejection by noting the Examiner provided no rationale for his conclusory statement that the claims are "clearly anticipated" by the device. (Pages 15 and 16 of November 1, 2004, Amendment). Rather than elaborating on the rationale underlying the rejection, in the Office Action dated January 24, 2005, the Examiner again repeated the bare assertion that the claims are "clearly anticipated" by the OCE 9400 device. (Page 3 of January 24, 2005, Office Action).

On June 22, 2005, Applicant appealed the Examiner's rejection under 35 U.S.C. § 102(b) to the Board of Patent Appeals and Interferences ("Board"). In the Appeal Brief, Applicant again noted that the Examiner provides no rationale for his conclusory statement that the claims are "clearly anticipated" by the OCE 9400 device and that is allegation was expressly refuted in the November 1, 2004, Amendment. (Page 21 of Appeal Brief). Furthermore, Applicant's Appeal Brief did not introduce any new evidence or arguments in traversing the Examiner's rejection.

In response, the Examiner issued an Examiner's Answer on August 8, 2005, and for the first time, set forth four pages of claim charts showing how he has been reading the claims on the

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Digital ES and Microstation Magazine (MSM Online) printouts allegedly relating to the OCE 9400 device. Only after reviewing this analysis was Applicant's representative able to grasp how the Examiner was trying to read the claims on the OCE 9400 device and able to understand how the Examiner was misinterpreting and/or misapplying the teachings of the references.

This realization prompted Applicant's representative to conduct a search on the Internet for documents relating to the OCE 9400 device. (*See* Paragraph 3 of Declaration under 37 C.F.R. § 1.132 (Attachment C)). As a result of this search, Applicant's representative discovered the User Manual for the OCE 9400 device, and prior to the search, Applicant's representative had no knowledge of the user manual. (*See* Paragraph 4 of Declaration under 37 C.F.R. § 1.132 (Attachment C)).

The User Manual for the OCE 9400 device clearly shows that structure and operation of the device is significantly different than how the Examiner characterized its structure and operation in the Examiner's Answer. Thus, Applicant relied on the disclosure of the user manual in its Reply Brief filed on October 11, 2005, to rebut the Examiner's reasoning presented for the first time in the Examiner's Answer. Moreover, since Applicant obtained the user manual by conducting an Internet search, the Examiner also could have easily discovered the user manual to confirm or deny his interpretation of the Digital ES and Microstation Magazine (MSM Online) printouts prior to issuing the Examiner's Answer.

On November 4, 2005, the Examiner issued a Communication indicating that he entered the Reply Brief and has considered it. In addition, not only did the Examiner consider the Reply Brief, the Board also has considered the Reply Brief.

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For example, on March 15, 2006, the Board remanded the case back to the Examiner and noted:

On October 11, 2005 appellant filed a reply brief including 41 pages of argument and comments concerning each of the nine rejections maintained by the examiner on appeal and separately addressing the examiner's various positions in the answer with regard to nearly all of the thirteen claims on appeal, eight of which are independent claims. The reply brief also included attached evidence [*i.e.*, the User Manual for the OCE 9400 device] relied upon by appellant in the arguments set forth on pages 30-35 of the reply brief. Our review of the record would appear to show that the reply brief represents appellant's *first opportunity* to respond to the full details of many of the examiner's rejections on appeal.

(Page 2 of March 15, 2006, Remand to the Examiner (emphasis added)). As noted above, the Board seems to acknowledge that the Reply Brief represented Applicant's first opportunity to respond to the Examiner's detailed reasons for rejecting the claims over the OCE 9400 device.

Furthermore, the Board noted that the Examiner's Communication of November 4, 2005, indicating that the Reply Brief has been "entered and considered" was "woefully inadequate in this particular case, since it fails to provide [the Board] with [the Examiner's] views concerning the numerous and specific arguments presented by appellant in the 41 pages of the reply brief."

(Pages 2 and 3 of March 15, 2006, Remand to the Examiner). As such, the Board stated that:

[W]e remand the application to the examiner for a full and complete response on the record to the many arguments and issues raised by appellant in the reply brief. A supplemental examiner's answer responsive to the above-noted reply brief would appear to be necessary.

(Page 3 of March 15, 2006, Remand to the Examiner (emphasis added)). Accordingly, the Board instructed the Examiner to fully and completely respond to the arguments in the Reply Brief and

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indicated that a Supplemental Examiner's Answer responsive to the Reply Brief appears necessary.

Instead of responding to Applicant's numerous and specific arguments in the Reply Brief, the Examiner issued the Supplemental Examiner's Answer that merely indicates that the Examiner has changed his mind and is not considering the Reply Brief because it relies on the User Manual for the OCE 9400 device. By failing to consider the Reply Brief and not fully and completely responding to the many arguments in the Reply Brief, the Examiner has disregarded the express mandate of the Board.

**II. Applicant respectfully requests entry of the Reply Brief filed October 11, 2005**

Applicant respectfully requests entry and consideration of the Reply Brief filed on October 11, 2005. The fact that the Applicant relies on the User Manual for the OCE 9400 device, for the first time, in the Reply Brief does not justify the Examiner disregarding the Board's instructions in its remand and refusing to fully and completely respond to each and every argument in the Reply Brief.

First, as noted above and acknowledged by the Board, the Reply Brief was Applicant's first opportunity to respond to the details of the Examiner's rejection based on the OCE 9400 device. While Applicant sought the Examiner's rationale underlying the conclusory nature of the rejection in the November 1, 2004, Amendment, the Examiner merely repeated the conclusory rejection in Office Action dated January 24, 2005.

Rather than providing any details of the anticipation rejection based on the OCE 9400 device in these two consecutive Office Actions, the Examiner waited until the Examiner's

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Answer to set forth four pages of analysis informing Applicant of his underlying rationale.

Moreover, since Applicant did not introduce any new evidence or arguments in its Appeal Brief to traverse the Examiner's rejection, the Appeal Brief included nothing which would have prompted the Examiner to elaborate on the reasoning underlying the rejection.

Faced with the details of the rejection for the first time, Applicant was able to assess the deficiencies in the rejection, which further enabled the Applicant to search for and find the User Manual for the OCE 9400 device and traverse the rejection based on the information contained in the manual. Since Applicant's discovery of the user manual directly resulted from the Examiner setting forth the detailed analysis, in the Examiner's Answer, underlying the rejection, Applicant respectfully requests entry and consideration of the Reply Brief, including the portions of the brief relying on the user manual.

Considering that a primary policy of prosecution is to "clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity" (M.P.E.P. § 706), Applicant submits that entry of the Reply Brief filed October 11, 2005, is the fairest remedy, which prevents further prejudice, cost and delay.

Applicant understands that 37 C.F.R. § 41.41 states that a Reply Brief should not include any new evidence, which encourages Applicant to identify any relevant evidence as early as possible during prosecution. However, in this case, the Examiner effectively suppressed the details of his rejection until he issued the Examiner's Answer. As such, preventing the Applicant from presenting new evidence in the Reply Brief handcuffs Applicant and prevents Applicant

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from having a chance to respond to the rationale underlying the rejection. Accordingly, Applicant respectfully submits that the Reply Brief filed October 11, 2005, be entered and considered.

**III. Alternatively, Applicant respectfully requests reopening prosecution**

While Applicant does not believe that the Examiner's Answer contains a new ground of rejection based on the OCE 9400 device, if the U.S. Patent and Trademark Office believes that the answer does, in fact, contain a new ground of rejection, Applicant submits that the Examiner should have treated the Reply Brief as a request to reopen prosecution under 37 C.F.R. § 41.39(b)(1) and (2). Thus, in the event that the Reply Brief is not entered, Applicant requests the Examiner to reopen prosecution and consider the User Manual for the OCE 9400 device.

**IV. Conclusion**

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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Grant K. Rowan  
Registration No. 41,278

Date: August 14, 2006



**ValueLine**

Oce  
Kip  
Xerox  
Ricoh  
Mita  
Neolt  
Showcase  
Model Number Index  
Trimmers  
Well-Loger

Home9476 Special NEW9800 Sales!Contact

A Word About Brokers  
Trade Terms & Practices

**DIGITAL ES****Oce' 9400**

Maximum Input Width	36	Exposure Control Auto, Manual	Auto
Maximum Input Length	18' to 37' Depending on memory	Reproduction Quality of Solids	Excellent
Maximum Output Width	36"	Reproduction Quality of Linework	Excellent
Maximum Output Length	50'Dependent on memory	Reproductions of Halftones	Good
Multiple Copies	1-99	Feet Per Minute	10
Reduction Capability	Yes	Copies Per Minute	Unknown
Enlargement Capability	Yes	Collating Capability	Electronic
Zoom Lens	25-400% in 1% steps	Analog or Digital Technology	Digital
Accuracy	+ or - .1%	Photoreceptor Type	OPC
Thick or Solid Originals	Yes	Toning System	Mono Component Toner
Auto or Manual Roll Feed	Auto	Other Features	Edge Adjustment
Auto or Manual Sheet Feed	-	Price Range at Introduction	40,000 Full System
Manual Paper By-Pass	Yes	Equipment Manufactured By	Oce'
Number of Rolls	1 or 2	Footprint and Height	53"W x 36"D x 44"H
Maximum Cassette Size	N/A	Weight	Unknown
Light-Dark Document Control	Yes	AC Power Requirements	120V

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December 1997

## New Products

### IDEAL, Xerox team to offer ScanCENTRAL copier/scanner

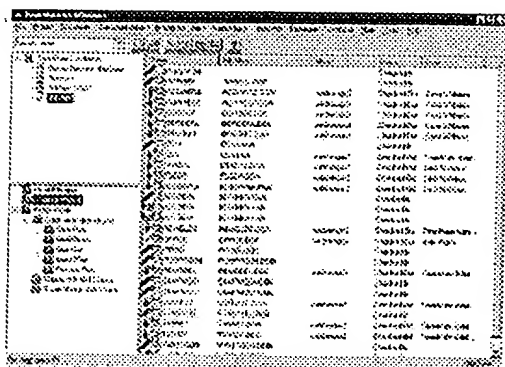
IDEAL Scanners & Systems (Rockville, Md.) has teamed with Xerox for the ScanCENTRAL copier and scanning solution, geared toward the GIS, engineering and reprographics markets. The core of the standalone ScanCENTRAL solution is IDEAL's Digital Blueprint Machine, a large-format, 36-inch wide scanner that directly interfaces to the Xerox 8830, a large-format, 36-inch wide printer.

ScanCENTRAL can copy and scan up to four E-size prints per minute. The Digital Blueprint Machine's built-in touch panel controls the copying, permitting the operator to make reductions and enlargements from 25 to 400 percent. The Xerox 8830 is designed to print all documents from A-size specification sheets to E-size engineering documents. The 8830's Xerox-patented development technology eliminates the need to change developer, lowering maintenance costs and maximizing uptime. The unit's three-roll media capacity features automatic roll switching.

#### READER SERVICE #202

### WorkPlace announces new ActiveAsset Inquirer module

In October, WorkPlace System Solutions (Boston) announced the release of ActiveAsset Inquirer. The Bentley Strategic Affiliate demonstrated its latest addition to



the ActiveAsset line at the Proactive Engineering Symposium, held October 16-18 in Palm Springs, Calif.

The server-based software unites the facilities department, engineering and corporate information systems, enabling enterprise-wide users to access information about equipment, facilities, engineering documents and personnel, via the Internet, corporate intranet or project extranet.

"ActiveAsset Inquirer makes it easier for organizations to share information with remote offices, clients, contractors and internal users who need only occasional access to engineering-related information," says George Church, president of WorkPlace. "Furthermore, because ActiveAsset Inquirer does not transfer the original file to the client computer, organizations can be assured that data security is not compromised."

The software dynamically generates Web pages, enabling users with Web browsers to navigate through the ActiveAsset database and view engineering drawings and graphical reports without specialized client software. Based on his or her individual user profile and security clearances, each user potentially sees different information.

ActiveAsset Inquirer leverages the potential of Bentley's ModelServer Publisher, which allows MicroStation design files and AutoCAD drawing files to be dynamically viewed and queried across a corporate intranet or the Internet.

For more information, visit  
[www.workplacesystems.com](http://www.workplacesystems.com).

#### READER SERVICE #208

#### Academic Suites shipping

New MicroStation Academic Suites for Plant/Processing and Mechanical Engineering are now shipping, rounding out Bentley's quartet of Academic Suites that

also includes Architecture and Geoengineering.

The Plant/Processing Academic Suite bundles MicroStation 95; PlantSpace P&ID from Jacobus; Opti SE Electrical Design, for creating electrical schematics for control and power systems; and ModelServer TeamMate, for integrated document and workflow management.

The Mechanical kit includes MicroStation 95, MicroStation Modeler, MicroStation MasterPiece, ModelServer TeamMate, ADAMS/MS Mechanisms and ESPRIT/MS PowerFold.

COSMOS/M DESIGNER ONE is available free to buyers from SRAC.

#### **READER SERVICE #201**

#### **Optiquest introduces 21-inch V115**



The new V115 from Optiquest is a 21-inch monitor with 20 inches of viewable screen space.

Optiquest (Walnut, Calif.) has introduced the 21-inch V115 monitor, featuring 20 inches of viewable screen space and compatible with both PC and Mac environments.

The flat-square monitor features a .26 mm dot pitch, a maximum resolution of 1,600 by 1,280 dpi and a refresh rate of 87 Hz at a resolution of 1,280 by 1,024 dpi. An Invar shadow mask withstands high heat levels, and OnView digital controls combine on-screen menus and button controls for adjusting image quality, size, position and geometry.

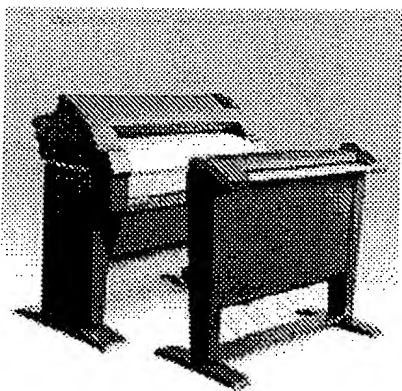
Estimated street price of the V115 is \$995.

#### **READER SERVICE #203**

#### **ZEH, Océ, team on printing solutions**

ZEH Graphic Systems (Houston) now offers plotting software support for the Océ 9400 and 9800 series printing/copying systems.

The ZEH support includes a batch processing capability that processes various



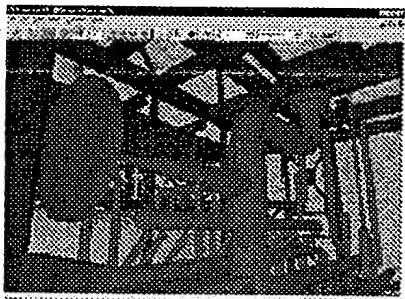
The Océ' 9400 (shown) and 9800 printer/copier systems now benefit from plotting software support from ZEH Graphic Systems.

Océ', "non-native" format files, such as CGM, PostScript, raster and others, to be translated through ZEH plotting software. The solution also supports all Océ, native formats accepted by the individual plotter/printer controller, and matches many of the individual machine's features, including roll selection, sorting, rotation and folding.

Plot Express, ZEH's sophisticated, scaleable UNIX-based file management software, completes the enterprise-wide printing solution, providing job submittal routines, system monitoring, load-balancing between devices and audit trails for project groups and departments.

#### READER SERVICE #204

#### Adaptive Media unveils network-based 3D streaming solution



Envision3D from Adaptive Media is a streaming solution for delivering 3D models over intranets/extranets.

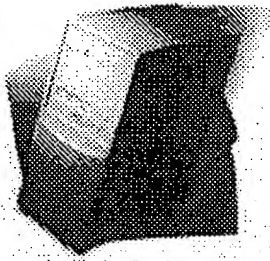
Adaptive Media (Sunnyvale, Calif.) is offering Envision3D, a network-based, 3D streaming software solution for delivery of industrial-size 3D models over corporate intranets and extranets.

Envision3D loads Virtual Reality Modeling Language (VRML) models 15 to 20 times faster than the traditional download-and-view methods, according to the company. A model 100 MB or larger in size, comprised of 2 million polygons and 30,000 objects, can be reduced to 39 MB and delivered immediately to the desktop. The same VRML model, delivered by traditional means, might take more than 50 minutes to download for viewing.

Components include:

- Envision3D MediaManager: Manages 3D model streaming across corporate LAN and WAN backbones to desktop users via standard Internet Protocol (IP).
- Envision3D Desktop: Provides Windows 95/NT-compatible, real-time control for viewing and navigating through complex 3D

	<p>models.</p> <ul style="list-style-type: none"> <li>• Envision3D Optimizer: Converts 3D files from industry-standard digital formats, such as VRML, into the Envision format, allowing viewing across the full range of desktops and network bandwidths.</li> </ul> <p><b>READER SERVICE #205</b></p>
<b>SGI introduces OpenGL Optimizer API</b>	<p>Silicon Graphics (Mountain View, Calif.) has introduced the OpenGL Optimizer API, a new technology that dramatically improves the ability of engineering applications to interact with and manipulate large three-dimensional data sets and models.</p> <p>The OpenGL Optimizer improves visualization of complex 3D models, reduces scene complexity by removing hidden objects and transparently uses multiple CPUs. SGI says the new API, built on the industry-standard OpenGL API, will increase 3D rendering performance two to 10 times for all OpenGL applications, with possible performance increases of 1,000 times or more. Features include enabling and enhancing real-time 3D data set design interaction, creation of multiple Levels of Detail (LOD), frustum and occlusion culling and integration of topological information.</p> <p>The API currently is available free of charge over the Internet for software development on the Silicon Graphics IRIX operating system. Microsoft Windows 95 and Windows NT versions also are available.</p> <p><b>READER SERVICE #206</b></p>
<b>NEC introduces Pentium II-based LE2200 Server</b>	<p>NEC Computer Systems (Mountain View, Calif.) has introduced the first Pentium II-based member of its Express5800 family of servers.</p> <p>The dual-processor LE2200 combines 9 GB hard drives and optional RAID controllers</p>



The LE2200 server from NEC is the company's first Pentium II-based model in the Express5800 family.

with Intel's Pentium II processor, which offers MMX and Error Correcting Code (ECC) memory on the integrated level 2 cache and fast compression/decompression of rich data types required by typical server applications. The LE2200's high-performance subsystem rapidly transfers data across two PCI and three ISA buses and eight drive bays, while the integrated PCI Ultra Wide SCSI controller supports up to four 9 GB hard disk drives.

A typical LE2200 entry-level configuration (single 233 MHz Pentium II processor, 32 MB ECC memory, Ethernet adapter and 4 GB hard drive) is priced at \$2,999.

#### **READER SERVICE #207**

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